

REMARKS

By this amendment, claims 4, 8 and 11 have been amended and claim 5 has been cancelled without prejudice or disclaimer. Claim 17 is newly added. Support for the instant amendments may be found throughout the embodiments disclosed in Applicant's as-filed specification. No new subject matter has been added. Accordingly, claims 4, and 6-17 are pending in the present application.

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. §112

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being as allegedly being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention. Claim 5 has been cancelled, and thus the rejection thereof is now moot.

Accordingly, Applicant requests that the rejection of claim 5 under 35 U.S.C. § 112, second paragraph, be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. §102

Claims 4-6, 8, 9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by International (PCT) Published Application No. WO 00/21005 to Walker et al. ("Walker") Applicant traverses this rejection for at least the following reasons.

Independent claims 4, 8 and 11 recite features drawn to a providing a Mix and Match (M&M) discount in a virtual mall. The features are amply supported by the disclosed embodiments in the written description. By way of example only, the disclosed embodiments provide that the M&M discount is achieved and performed when at least two different items subject to the M&M discount are respectively purchased from different shops in the virtual mall. When a purchaser buys one item subject to M&M discount in one of the shops, the purchaser is notified that the purchased item is subject to the M&M discount. [See Applicant's Specification; pg. 13, lines 8-19 and FIG 12]. Further, the notification may further include notifying the purchaser that the purchaser can get the M&M discount if the purchaser buys at least one other

M&M item at a different shop. [See Applicant's Specification; FIG. 12: M2]. Therefore, the purchaser is potentially motivated to go to another shop and buy at least one other item subject to an M&M discount to get the M&M discount.

The Office Action alleges that Walker anticipates claims 4-6, 8, 9, 11 and 12. [See Office Action, pg. 3]. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

First, the Office Action alleges that reference 1020 (FIG. 10) of Walker is an M&M discount item flag indicating that the purchase item is an M&M discount item, the M&M discount item flag being set where the purchased item is specified as an M&M discount item by one of the plurality of shops. [Office Action, pg. 3]. Further, the Office Action alleges that "[s]ince Walker teaches that a criteria for offering the discount could be a required purchase from a 1st merchant and a criteria for redeeming the discount could be a required purchase for a 2nd merchant, all items subject to this criteria must have the associated discount item flag." [Office Action, pg. 3]. Applicant disagrees with these assertions and the conclusions inherent therein.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Applicant submits that just because Walker may teach awarding a bonus to a customer for performing transactions at different merchants (i.e., the outputting and soliciting merchants), it does not necessarily follow that Walker teaches that the bonus is a discount that is achieved when the customer purchasers at least one item subject to the discount from each of the outputting and soliciting merchants. Rather, in Walker individual items are not subject to the bonus – *only transactions are*. [See Walker, pg. 16 lines 13-15; pg. 17, lines 3-5; pg. 18, lines 9-11]. For example, in Walker the customer may receive a bonus, for example, expressed as a percentage off a transaction which may be unrelated to the item purchase. [See Walker, pg. 16 lines 13-15].

By contrast, in Applicant's claimed invention, the discount can only be achieved when at least one item subject to the M&M discount is respectively purchased from at least two different

shops. [See Applicant's Specification, FIG. 13 (*Compare* treatment of Items aaa and ccc with Item bbb)]. The cited portions of Walker, however, provide no indication that the customer must purchase an item subject to a discount from each of the outputting and soliciting merchants in order to receive a bonus. As such, Walker fails to teach the claimed "Mix & Match (M&M) discount" that is achieved when at least one item subject to the M&M discount is respectively purchased from at least two different shops.

Moreover, Walker fails to teach (means for) generating a purchased item data when a purchase command is input, the purchase command indicating that a purchaser buys an item at one of the plurality of shops, the purchased item data including ... an M&M discount item flag indicating that the purchased item is an M&M discount item, the M&M discount item flag being set where the purchased item is specified as an M&M discount item by one of the plurality of shops. Because Walker fails to teach that an item may be subject to an M&M discount, Walker also fail to teach generating an M&M discount item flag indicating that the purchased item is an M&M discount item. At most, Applicant submits that Walker may provide a flag indicating the occurrence (or non-occurrence) of a particular transaction, so as to validate that the customer satisfies the conditions of the bonus. [See Walker, pg. 17, lines 13-14]. While the bonus identifier 1020 (FIG. 10) of Walker (alleged by the Office Action to correspond to the claimed discount item flag), may include a required item to purchase 1030, if any, there is no indication that the bonus corresponds to the item to purchase 1030. [See Walker, pg. 17, lines 17-21].

Walker also fails to teach (means for) notifying the purchaser that the purchased item is subject to the M&M discount based on the M&M discount item flag. While the first (outputting) merchant in Walker may notify a customer of a bonus for making a further transaction at a second (soliciting) merchant, Walker provides no indication that the first (outputting) merchant (or other features) notifies the customer that the purchased item is subject to a discount. Rather, it appears from Walker that the customer is only notified of some future transaction with another merchant, which may include the purchase of an item. [See Walker, pg. 16, lines 13-15].

Similarly, Walker fails to teach (means for) discriminating whether items indicated by at least two M&M discount item flags in a plurality of purchased item data are respectively purchased from different shops based on the purchased item data. Because Walker fails to fails to teach that an item may be subject to an M&M discount and generating M&M discount item

flags, Walker also fails to teach discriminating whether items purchased at the outputting merchant and the soliciting merchant are subject to an M&M discount.

Lastly, Walker fails to teach (means for) executing an M&M discount if the discriminating means determines that the items indicated by the at least two M&M discount item flags are respectively purchased from different shops. At most, Walker teaches executing a discount (e.g., 10% OFF) on the entire transaction. [*See, e.g.*, Walker, pg. 16, lines 13-15; pg. 18, lines 3-5 and lines 9-11].

For at least the foregoing reasons, Applicant submits that the cited portions of Walker do not disclose or teach each and every limitation of claims 4, 8 and 11 and thus, claims 4, 8 and 11 are patentable over Walker. Claims 6, 9 and 12 depend from claims 4, 8 and 11 respectively and are, therefore, patentable for at least the same reasons provided above related to claims 4, 8 and 11, and for the additional features recited therein. Claim 5 has been cancelled, and thus, the rejection thereof is now moot.

Moreover, with regard to claims 6, 9 and 12, the Office Action alleges that “if two items are purchased from a merchant (regardless of the discount item flags), both items have been selected for purchase by the consumer.” [Office Action, pg. 4]. Applicant disagrees with this assertion for at least the reason that this logic ignores the claim language on its face. Notwithstanding that the Office Action has apparently ignored the “means for” recitation in claim 6 (which requires the Examiner to interpret the claim limitation in light of the “means” disclosed in Applicant’s Specification), Walker fails to teach selecting one item from at least two different items indicated by at least two M&M discount item flags if the at least two different items indicated by the at least two M&M discount item flags are purchased at the same shop. For example, Walker provides no indication of what happens when a customer purchases two or more items from the same merchant. Moreover, assuming, *arguendo*, that at least one of those items was required to be purchased to receive a bonus, it appears that the customer would receive a bonus, for example, expressed as a percentage off the entire transaction (i.e., the purchase of all the items from the that merchant). [*Se, e.g.*, Walker, pg. 16 lines 13-15].

Thus, Applicant respectfully requests that the rejection of claims 4 and 6-16 under 35 U.S.C. §102(b) in view of Walker should be withdrawn and the claims be allowed.

III. NEW CLAIM 17

New claim 17 recites similar subject matter as claims 4 and 6 above, and thus is, patentable for at least the same reasons provided above related to claims 4 and 6, and for the additional features recited therein.

IV. CONCLUSION

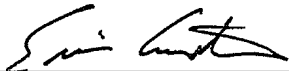
All matters having been addressed and in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant's representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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